

Attorney Docket: 060258-0290657
Client Reference: 2990360US/Sml/jku



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of:
LAURILA, ET AL.

Confirmation Number: 9575

Application No.: **10/082,348**

Group Art Unit: 2617

Filed: February 26, 2002

Examiner: IQBAL, Khawar

Title: UTILIZATION OF SUBSCRIBER DATA IN A TELECOMMUNICATION SYSTEM

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After-Final
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the Final Office Action (hereinafter "Final Action") mailed June 6, 2008, and the Advisory Action mailed September 30, 2008, Appellants request a review of the Final Rejection in the above-referenced application. This request is being filed concurrently with a Notice of Appeal.

The review is requested for the reasons set forth in the **Remarks** beginning on page 2 of this paper.

A total of 5 pages are provided.

It is not believed that extensions of time are required beyond those that may otherwise be provided for in documents accompanying this paper. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby petitioned for under 37 C.F.R. § 1.136(a), and are hereby authorized to be charged to our Deposit Account No. 033975 (Ref. No. 060258-0290657).

REMARKS

Claims 1-7, 9-23, 25, and 27-31 are pending in this application. Claims 1-7, 9-23, 25, and 27-31 stand rejected.

At the outset, Appellants note that the Examiner has failed to specifically address claims 12 and 23 in the Final Action. Accordingly, the Final Action is incomplete. Nonetheless, Appellants request review for the rejection of claims 1-7, 9-11, 13-22, 25, and 27-31 under 35 U.S.C. § 102(e).

In view of the following comments, allowance of all the claims pending in the application is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

Review is requested for the rejection of claims 1-7, 9-11, 13-22, 25, and 27-31 under 35 U.S.C. § 102(e) as allegedly being anticipated by U.S. Patent No. 6,501,746 to Leung. ("Leung") [Final Action, pg. 2, ¶12].

The rejection of claims 1-7, 9-11, 13-22, 25, and 27-31 under 35 U.S.C. § 102(e) is improper for at least the reason that Leung fails to disclose or suggest each and every feature of Appellants' pending claims.

For example, Leung fails to disclose or suggest at least the following features recited in independent claim 1:

creating ***at least one database comprising subscriber data, from which there is a functional connection to the bearer network***, said subscriber data ***being similar to the data stored in a subscriber application comprised by the terminal***, the subscriber data including authentication information;

establishing ***a connection between the serving network and the terminal via the subscriber application comprised by the terminal***;

automatically ***transmitting, from the subscriber database, subscriber data*** to the terminal, the serving network, or the terminal and the serving network, ***in response to the terminal having the right to use said subscriber database and in response to acceptable authentication of the subscriber database in the bearer network***;

One aspect of Appellants' invention relates to providing telecommunication services by creating a database that is in functional connection with a bearer network, in which the database comprises subscriber data that is similar to the data stored in a subscriber

application (e.g., UMTS Subscriber Identity Module (USIM) application) comprised by a terminal. Thus, per various embodiments of Appellants' invention, subscriber data that was conventionally only stored in the subscriber application comprised by the terminal, is stored in a database that is in functional connection with the bearer network. The subscriber data stored in the database is used to provide the terminal with telecommunication services. Appellants' as-filed Specification, at paragraphs 15-18 and 26-28, describes various problems with conventional systems and the advantages obtained by the embodiments of Appellants' invention.

In dramatic contrast, Leung relates to IP address assignment in a Mobile IP system. In particular, Leung is directed to assigning an IP address to a mobile node during registration which is accomplished by mapping a mobile node ID (associated with the mobile node) to an assigned IP address. A registration request is sent by the mobile node to a Home Agent. Once an IP address is assigned to the mobile node, the IP address may be transferred to the mobile node in a registration reply composed by the Home Agent.

In the Advisory Action, the Examiner erroneously alleges that Leung's "mobile node ID" of a mobile node (allegedly the claimed terminal) discloses the claimed "subscriber application" that stores data and is comprised by the terminal. Clearly, a mobile node identifier is not the same as a "subscriber application", for example, a USIM application, that stores data and is comprised by a terminal.

Appellants' as-filed Specification, clearly specifies that a "subscriber application", such as a USIM application, stores data and is comprised by a terminal (particularly, that the USIM application is stored on a smart card in the terminal) [See, for example, paragraphs 10 and 21 of the as-filed Specification]. Indeed, "[d]uring patent examination, the pending claims must be "given their broadest reasonable interpretation *consistent with the specification*." Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Thus, even under the broadest reasonable interpretation standard, one of ordinary skill in the art, in light of the specification, would not interpret a mobile node identifier to be the same as the claimed "subscriber application" which stores data and is comprised by a terminal.

Also, Leung, at column 5, lines 1-7, states "... mobile node will typically have a unique *mobile node ID* such as that used by the manufacturer (e.g., a *serial number* or *MAC*

address). Thus, Leung discloses that the mobile node ID may be a serial number or a MAC address, which is clearly not the same as a “subscriber application”, for example, a USIM application, that stores data and is comprised by a terminal. In fact, Appellants submit that there is absolutely no mention or suggestion of Leung’s mobile node comprising the claimed subscriber application.

Furthermore, assuming *arguendo*, that Leung’s Home Agent is analogous to Appellants’ bearer network and Leung’s mobility binding table is analogous to Appellants’ database (though Appellants do not concede these assumptions), there is no disclosure in Leung of: i) the mobility binding table being in functional connection with the Home Agent, ii) data in the mobility binding table (allegedly the subscriber data) being similar to the data stored in the subscriber application comprised by the terminal, or iii) the data in the mobility binding table including authentication information.

Moreover, since Leung fails to disclose the claimed subscriber application, Leung also fails to disclose that a connection between the foreign agent (allegedly the serving network) and the mobile node is established via the subscriber application comprised by the terminal.

Appellants further submit that if the Examiner is equating Leung’s mobility binding table to Appellants’ database, the data in the mobility binding table would allegedly correspond to Appellants’ subscriber data (though Appellants do not concede this interpretation). Under this interpretation, it appears that the Examiner relies on the mobile node ID (which is included in the mobility binding table) to correspond to *both* the claimed subscriber data and the claimed subscriber application (as indicated above), which is legally improper as both these claim elements cannot be interpreted to be equivalent to the same thing. Indeed, “[T]he use of two terms in a claim requires that they connote different meanings....” *Applied Med. Res. Corp. v. U.S. Surgical Corp.*, 448 F.3d 1324, 1333 n.3 (Fed. Cir. 2006).

The Examiner further alleges that Leung discloses the subscriber data being automatically transmitted from the subscriber database to the terminal, the serving network, or the terminal and the serving network, in response to the terminal having the right to use the subscriber database and in response to acceptable authentication of the subscriber database in the bearer network. Appellants strenuously disagree with the Examiner’s assessment. Leung discloses that the home agent composes and sends a

registration reply to the mobile node, via the foreign agent, wherein the registration reply includes the identifying portion of the mobile node ID [Leung, at column 8, lines 5-12, and column 12, lines 13-20]. Under the interpretation that the mobile node ID corresponds to Appellants' subscriber data, Leung discloses transmission of registration reply (including the mobile node ID) from the Home agent and not the mobility binding table (allegedly the subscriber database). Moreover, Leung fails to disclose the transmission of the registration reply *in response to the mobile node having the right to use the mobility binding table and in response to acceptable authentication of the mobility binding table*. In fact, there is no mention in Leung of authenticating the mobility binding table.

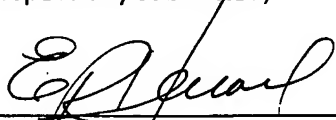
Thus, for at least these reasons, Leung clearly fails to disclose each and every feature of independent claim 1, and the rejection is improper and should be withdrawn. Independent claims 13, 25, and 31 recite similar features as claim 1, so the rejection of claims 13, 25, and 31 is likewise improper and must be withdrawn for at least the reasons presented relative to claim 1. Dependent claims 2-7, 9-12, 14-23, and 27-30 are allowable because they depend from allowable independent claims, as well as for the further features they recite.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Date: **October 31, 2008**

Respectfully submitted,

By:



E. Rico Hernandez
Registration No. 47,641

Customer No. 00909

PILLSBURY WINTHROP SHAW PITTMAN LLP
P.O. Box 10500
McLean, Virginia 22102
Direct Dial: 703-770-7788
Main: 703-770-7900
Fax: 703-770-7901